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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/599,924	06/22/2000	Kenneth A. Milnes	39744/PYI/S787	8016

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EXAMINER

SALCE, JASON P

ART UNIT	PAPER NUMBER
2611	7

DATE MAILED: 09/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/599,924

Applicant(s)

MILNES ET AL.

Examiner

Jason P Salce

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 June 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 31-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 31-40 is/are rejected.
- 7) ☒ Claim(s) 32 and 37 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 June 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 3.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Information Disclosure Statement*

1. The information disclosure statement (IDS) submitted on 6/02/2001 was filed ~~after the mailing date of the initial filing of the instant application on 06/22/2000.~~ The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner is considering the information disclosure statement.

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 31-40 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,118,492. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 31-40 of the instant application are broader than claims 1-5 of the 492' patent, therefore, the claims in the instant application are anticipated by the patent claims (See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993)), thereby disclosing all of the limitations in the instant application.

For example, note the following relationship between claim 1 of the '492 patent and claim 31 of the instant application:

(a) "A method of operating a schedule guide system comprising: storing data containing television schedule information, including titles of current and future television shows for particular channels in a computer readable memory" of the instant application corresponds to "A method of operating a schedule guide system comprising: storing data containing television schedule information, including titles of current and future television shows for particular channels in a computer readable memory" of the '492 patent.

(b) "displaying a plurality of cells listing a portion of a schedule guide based on said stored data and the television shows presently available for viewing over substantially all of a screen" of the instant application corresponds to "selectively displaying a plurality of cells listing a portion of the guide based on said stored data and the television shows presently available for viewing over substantially all of said screen" of the '492 patent.

(c) "visually distinguishing portions of cells corresponding to portions of current television shows in play from cells corresponding to future television shows and portions of cells corresponding to portions of current television shows yet to be played" of the instant application corresponds to "visually distinguishing portions of cells corresponding to portions of current television shows in play from cells corresponding to future television shows and portions of cells corresponding to portions of current television shows yet to be played" of the '492 patent.

Accordingly, claims 32-35 of the instant application corresponds to claims 2-5 of the '492 patent, respectively.

Accordingly, claims 36-40 of the instant application also correspond to claims 1-5 of the '492 patent, where the '492 patent also teaches the limitation of "an overlay to a current television show" as required in claim 36 of the instant application.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 31 and 35 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Lett et al. (U.S. Patent No. 5,592,551).

Referring to claim 31, Lett discloses storing data containing television schedule information (see Column 13, Lines 8-10 for storing an EPG transmitted from a headend in RAM), including titles of current and future television shows for particular channels in a computer readable memory (see titles of current shows (any show that can be selected during 8:15 (current time)) and future shows (any show displayed after 8:15, such as Home Improvement, starting at 8:30)).

Lett also discloses displaying a plurality of cells listing a portion of a schedule guide based on said stored data (see Column 13, Lines 31-43 and Figure 5 for only

displaying a portion of the schedule (from 8pm to 10pm)) and the television shows presently available for viewing over substantially all of a screen (see Figure 5 for multiple shows available for viewing).

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Lett also discloses visually distinguishing portions of cells corresponding to portions of current television shows in play (see Figure 5 for all cells that are playing at 8:15, for example, Full House and Evening Shade play from 8pm to 8:30pm, therefore, these cells represent a show that is in play) from cells corresponding to future television shows and portions of cells corresponding to portions of current television shows yet to be played (see Figure 5 for future shows and current shows that have yet to be played, for example, Home Improvement and Major Dad play during 8:30pm to 9pm, therefore these shows play after a current time of 8:15pm and are therefore future or current shows that have yet to be played). The examiner notes that future shows and current shows (shows that are currently displayed in the EPG) are equivalent, because both reside in a time slot that is not playing during the current time (such as Major Dad).

Referring to claim 35, Lett discloses displaying a cell division line between television shows to indicate that a show is already in play (see Figure 5 for the division line between Full House and Home Improvement and note that since the current time is 8:15pm, then Full House is the current program in play and is divided by a division line to separate the future show (Home Improvement)).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lett et al. (U.S. Patent No. 5,592,551) in view of Aristides et al. (U.S. Patent No. 5,657,072).

Referring to claim 33, Lett discloses that the TV schedule information is updated every half hour (see Column 13, Lines 21-23), but fails to teach updating the schedule information a few minutes before the half hour. Aristides discloses defining a peak time from 8:25 to 8:35 and updating the EPG before the peak time (a few minutes before the half hour) (see Column 7, Lines 49-61).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the updating of the schedule information every half hour, as taught by Lett, using the updating of the schedule information a few minutes before the half hour (before 8:25), as taught by Aristides, for the purpose of alleviate the bottleneck associated with handling many requests during peak activity (see Column 3, Lines 7-9 of Aristides).

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5. Claims 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lett et al. (U.S. Patent No. 5,592,551) in view of Aristides et al. (U.S. Patent No. 5,657,072) in further view of Hamilton et al. (U.S. Patent No. 5,579,055).

Referring to claim 34, Lett and Aristides discloses all of the limitations in claims 31 and 33, but fail to disclose updating the schedule information approximately three minutes before the half hour. Hamilton discloses that an EPG can be updated at any

time, therefore the update can inherently take place approximately three minutes before the half hour, along with every half hour and a few minutes before the half hour (see Column 12, Lines 39-43).

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~~At the time the invention was made, it would have been obvious to modify~~  
updating the schedule information every half hour or few minutes before the half hour, as taught by Lett and Aristides, using the updating at any time, as taught by Hamilton, for the purpose of removing EPG data that has already been accessed and is no longer contains relevant program selections because the broadcast time has already passed (see step 504 in Figure 5 and Column 12, Lines 25-29 of Hamilton).

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6. Claims 36 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lett et al. (U.S. Patent No. 5,592,551) in view of Marshall et al. (U.S. Patent No. 5,502,504).

Referring to claim 36, Lett discloses storing data containing television schedule information (see Column 13, Lines 8-10 for storing an EPG transmitted from a headend in RAM), including titles of current and future television shows for particular channels in a computer readable memory (see titles of current shows (any show that can be selected during 8:15 (current time)) and future shows (any show displayed after 8:15, such as Home Improvement, starting at 8:30)).

Lett also discloses displaying a plurality of cells listing a portion of a schedule guide based on said stored data (see Column 13, Lines 31-43 and Figure 5 for only displaying a portion of the schedule (from 8pm to 10pm)) and the television shows



presently available for viewing over substantially all of a screen (see Figure 5 for multiple shows available for viewing).

Lett also discloses visually distinguishing portions of cells corresponding to ~~portions of current television shows in play (see Figure 5 for all cells that are playing at~~ 8:15, for example, Full House and Evening Shade play from 8pm to 8:30pm, therefore, these cells represent a show that is in play) from cells corresponding to future television shows and portions of cells corresponding to portions of current television shows yet to be played (see Figure 5 for future shows and current shows that have yet to be played, for example, Home Improvement and Major Dad play during 8:30pm to 9pm, therefore these shows play after a current time of 8:15pm and are therefore future or current shows that have yet to be played). The examiner notes that future shows and current shows (shows that are currently displayed in the EPG) are equivalent, because both reside in a time slot that is not playing during the current time (such as Major Dad).

Lett fails to disclose overlaying the schedule information on a current television show. Marshall discloses overlaying an EPG on a television program (see Figure 6). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the EPG, as taught by Lett, using the overlay device, as taught by Marshall, for the purpose of preventing a viewer from missing key portions of the program on the previously selected channel while selecting a new program to view (see Column 1, Lines 11-15 of Marshall).

Claim 40 corresponds to claim 36, where Lett discloses displaying a cell division line between television shows to indicate that a show is already in play (see Figure 5 for

the division line between Full House and Home Improvement and note that since the current time is 8:15pm, then Full House is the current program in play and is divided by a division line to separate the future show (Home Improvement)).

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7. Claim 38 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lett et al. (U.S. Patent No. 5,592,551) in view of Marshall et al. (U.S. Patent No. 5,502,504) further view of Aristides et al. (U.S. Patent No. 5,657,072).

Referring to claim 33, Lett and Marshall disclose that the TV schedule information is updated every half hour (see Column 13, Lines 21-23), but fails to teach updating the schedule information a few minutes before the half hour. Aristides discloses defining a peak time from 8:25 to 8:35 and updating the EPG before the peak time (a few minutes before the half hour) (see Column 7, Lines 49-61).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the updating of the schedule information every half hour, as taught by Lett and Marshall, using the updating of the schedule information a few minutes before the half hour (before 8:25), as taught by Aristides, for the purpose of alleviate the bottleneck associated with handling many requests during peak activity (see Column 3, Lines 7-9 of Aristides).

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8. Claims 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lett et al. (U.S. Patent No. 5,592,551) in view of Marshall et al. (U.S. Patent No. 5,502,504) in

further view of Aristides et al. (U.S. Patent No. 5,657,072) in further view of Hamilton et al. (U.S. Patent No. 5,579,055).

Referring to claim 34, Lett, Marshall and Aristides discloses all of the limitations in claims 31 and 33, but fail to disclose updating the schedule information approximately three minutes before the half hour. Hamilton discloses that an EPG can be updated at any time, therefore the update can inherently take place approximately three minutes before the half hour, along with every half hour and a few minutes before the half hour (see Column 12, Lines 39-43).

At the time the invention was made, it would have been obvious to modify updating the schedule information every half hour or few minutes before the half hour, as taught by Lett, Marshall and Aristides, using the updating at any time, as taught by Hamilton, for the purpose of removing EPG data that has already been accessed and is no longer contains relevant program selections because the broadcast time has already passed (see step 504 in Figure 5 and Column 12, Lines 25-29 of Hamilton).

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***Allowable Subject Matter***

9. Claims 32 and 37 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is an examiner's statement of reasons for allowance:

The prior art of record fails to anticipate or rendered obvious distinguishing current television shows from future television or current television shows that have yet

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to be played using color-coding on the displayed schedule information. The prior art teaches color-coding EPGs according to the specific source of programs (see Column 7, Lines 10-16 of Klosterman (U.S. Patent 5,684,525)) or the specific program category (see Column 4, Lines 15-17 of Bedard (U.S. Patent No. 5,793,438)). Therefore, claims

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32 and 37 are allowable over the prior art.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

#### ***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason P Salce whose telephone number is (703) 305-1824. The examiner can normally be reached on M-Th 8am-6pm (every other Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on (703) 305-4380. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

August 20, 2004



CHRIS GRANT  
PRIMARY EXAMINER